UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,501	08/05/2003	Darrell Anderson	Google-54 (GP-064-06-US)	8674

82402 7590 11/09/2009

Straub & Pokotylo
788 Shrewsbury Avenue
Tinton Falls, NJ 07724

EXAMINER	
AL HASHEMI, SANA A	

ART UNIT	PAPER NUMBER
2156	

MAIL DATE	DELIVERY MODE
11/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/634,501	ANDERSON ET AL.	
	Examiner	Art Unit	
	Sana Al-Hashemi	2156	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,13,18-22,29-44,54,59-63 and 70-82* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,13,18-22,29-44,54,59-63 and 70-82* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/21/09, 9/3/08, 4/15/08, 2/11/08, 7/16/07, 11/23/05, 7/18/05, 2/28/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is issued in response to applicant amendment/RCE filed 10/20/09.

Claims 1-3, 13, 18-22, 29-44, 54, 59-63, 70-82 were amended. No claims were added. Claims 4-12, 14-17, 23-28, 45-53, 55-58, and 64-69, were canceled.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/20/09 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 13, 18-19, 29-32, 35-38, 40, 43-44, 54, 59-60, 70-73, and 76-79, are rejected under 35 U.S.C. 102(b) as being anticipated by Dwight Merriman (U.S. Patent No. 5,948,061 issued Sep. 7, 1999. (Merriman hereinafter).

Regarding Claims 1, 13, 42, 54-57 and 64 Merriman discloses a computer-implemented method of use by an ad server system including at least one computer on a network, in an environment including a client device and the ad server system, the computer-implemented method comprising:

a) accepting by the ad server system, document relevance information including at least one concept extracted from content of a document requested by the client device ((Fig. 1, element 19, Col 2, Lines 15-25; see also Col 2, Lines 65-66; see also Col 3, Lines 5-8; see also Col 3, Lines 24-34, Merriman), wherein relevance information is generated and sent to the ad server system (Col 2, Lines 25-30; see also Col 3, Lines 12-15; See also Col 3, Lines 34-59, i.e. determine), by at least one of (A) a browser application on the client device (Fig. 1, element 19, Col. 3, lines 24-30, Merriman), (B) a browser plug-in on the client device and (C) a browser toolbar on the client device, wherein the document relevance information is automatically extracted from the document requested [Since the claim discloses at least one art is applied only to step (A)](Col. 3,lines 30-35, Merriman);

b) determining by the server system, at least one ad relevant to content of the document using at least the accepted information to find matching serving constraints stored in association with ads (Col 2, Lines 25-30; see also Col 3, Lines 12-15; See also Col 3, Lines 34-59, i.e. determine); and

c) sending by the ad server, the at least one ad determined to the client device (Col 2, Lines 25-38; see also Col 3, Lines 59-63; see also Col 6, Lines 56-69).

Regarding Claims 2 and 43, Merriman discloses a computer-implemented method wherein the act of determining at least one ad relevant to the content of the document further uses at least ad relevance information (Col 3, lines 34-59; see also Col 6, Lines 12-26).

Regarding Claims 3 and 44, Merriman discloses a computer-implemented method wherein the ad relevance information includes an ad concept (Col 3, Lines 34,38; see also Col 4, Lines 44-55; see also Col 6, lines 11-26).

Regarding Claims 18 and 59, Merriman discloses at least one of the at least one content-relevant ad received includes rendering the at least one of the at least one content-relevant ad in association with the content of the requested document (Col 2, Lines 25-38; see also Col 3, Lines 59-63; see also Col 6, Lines 56-69).

Regarding Claims 19, 65, Merriman discloses rendering the content of the document in a first window, wherein the at least one of the at least one content- relevant ad received is rendered in a second window (Col 3, Lines 5-15; see also Col 1, Lines 29-44).

Regarding Claims 29-32 and 70-73, Merriman discloses rendering content of the requested document, wherein the act of rendering content of the requested document is initiated before the act of submitting a request (please see Merriman Figure No. 1, Element No. 16 to 20 then 12 to 22 and corresponding text; see also Col 2, Lines 15- 36).

Regarding Claims 35-36 and 76-77, Merriman discloses rendering, by the client device, the content of the document in a first part of a browser window, wherein the at least one of the at least one content-relevant ad received is rendered in the second part of the browser window, wherein the second part of the browser window shares no space with the first part of the browser window (Col 3, Lines 5-15; see also Col 1, Lines 29-44; see also Col 2, Lines 15-36).

Regarding Claims 37-38 and 78-79 Merriman discloses wherein the second part of the browser window is a browser chrome part and/or a toolbar of the browser window (Col 3, Lines 24-63, specifically Lines 24-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 20-22 and 61-63, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dwight Merriman (U.S. Patent No. 5,948,061 and Merriman hereinafter).

Regarding Claims 20-22 and 61-63 though Merriman reference discloses examples of locations where an ad maybe displayed (please see Col 1, Lines 32-36). Yet Merriman's reference does not expressly show the rendering location of an ad window compared to the location content of a document, such as a web page window location. However these differences are only found in the nonfunctional descriptive material and do not alter the functionality of rendering a window; the location of a window (i.e., the descriptive material does not reconfigure

the rendering). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to render any window in any location because the window location for the ad does not alter the rendering functionality and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claims 33-34, 39-41, 74-75 and 80-82, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dwight Merriman (U.S. Patent No. 5,948,061 and Merriman hereinafter) in view of Franklin Servan-Schreiber (U.S. Patent No. 6,892,354 and Servan-Schreiber hereinafter).

Regarding Claims 33-34, 39-41, 74-75 and 80-82 Merriman reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate wherein the act of submitting a request for at least one content-relevant ad to the content-relevant ad server occurs before a request for the requested document. However, Servan-Schreiber discloses wherein the act of submitting a request for at least one content-relevant ad to the content-relevant ad server occurs before a request for the requested document (Col 3, Lines 56-67). Given the intended broad application of Merriman's system, It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Merriman with the teachings of Servan-Schreiber to include the feature of submitting a request for at least one content-relevant ad to the content- relevant ad server occurs before a request for the requested document to keep the user or the requester interested in document or the web site he/she

requested by presenting and/or displaying advertisements to the user or the requester while the requested web site is downloading, especially for those advertisements that are significantly small in size comparing to the size of a web site.

Response to Arguments

Applicant's arguments filed 10/20/09 have been fully considered but they are not persuasive.

Applicant argues the applied art fails to disclose accepting by the ad server system, document relevance information including at least one concept extracted from content of a document requested by the client device, wherein relevance information is generated and sent to the ad server system, by at least one of (A) a browser application on the client device, (B) a browser plug-in on the client device and (C) a browser toolbar on the client device, wherein the document relevance information is automatically extracted from the document requested.

Examiner disagrees. the applied art discloses all the argued limitations, accepting by the ad server system, document relevance information including at least one concept extracted from content of a document requested by the client device ((Fig. 1, element 19, Col 2, Lines 15-25; see also Col 2, Lines 65-66; see also Col 3, Lines 5-8; see also Col 3, Lines 24-34, Merriman), wherein relevance information is generated and sent to the ad server system (Col 2, Lines 25-30; see also Col 3, Lines 12-15; See also Col 3, Lines 34-59, i.e. determine), by at least one of (A) a browser application on the client device (Fig. 1, element 19, Col. 3, lines 24-30, Merriman), (B)

a browser plug-in on the client device and (C) a browser toolbar on the client device, wherein the document relevance information is automatically extracted from the document requested [Since the claim discloses at least one art is applied only to step (A)](Col. 3,lines 30-35, Merriman).

Applicant argues the applied art fails to disclose "relevant to the content of the documents requested by the end user.

Examiner disagrees. The applied art at Col. 4, line 1-11, discloses the argued limitation.

The Applicant arguments have been carefully reviewed in view of the applied art and Examiner believes the art applied met all the claimed limitations as amended.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sana Al-Hashemi whose telephone number is 571-272-4013. The examiner can normally be reached on 8Am-4:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pierre Vital can be reached on 571-272-4215. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sana Al-Hashemi/
Primary Examiner, Art Unit 2156
October 30, 2009